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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO.       |
|--|-------------|----------------------|------------------------------|------------------------|
| 10/667,297   | 09/19/2003  | Antti Vaha-Sipila    | 915-008.014                  | 8405                   |
| 4955 7590 01/30/2008<br>WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP<br>BRADFORD GREEN, BUILDING 5<br>755 MAIN STREET, P O BOX 224<br>MONROE, CT 06468 |             |                      | EXAMINER<br>GERGISO, TECHANE |                        |
|  |             |                      | ART UNIT<br>2137             | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>01/30/2008      | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/667,297

Applicant(s)

VAHA-SIPILA, ANTTI

Examiner

Techane J. Gergiso

T-C

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. This is a Final Office Action in response to the applicant's communication filed on October 31, 2007.
2. Claims 20-23 have been examined and are pending.

### *Response to Arguments*

3. Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive.
4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., The applicant argues that the **order or sequence** of the steps to be carried out in the method is **essential or critical** to the claimed invention to distinguish over the applied prior art; see applicant's argument page 2, last paragraph; "The transmit step 203 of Fig. 2 takes place in the terminal and follows a hash step, 201 that also takes place in the terminal" and "This is critically important for the present invention because the "communicating" is quite different from that disclosed by Geiger as will be appreciated by reference to the transmitting and receiving steps of claim 20. These are best illustrated by reference to Fig. 2 of the present application at steps 203 and 209." See also page 3: paragraph 1 and 4. The **order or sequence** of the steps to be carried as **essential or critical** to the claimed invention including **necessary intermediate steps** like step 201, 205, 207, 211-217 of figure 2) are not recited in the rejected claim(s). Although the claims

are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. From the applicant's argument, if the **order or sequence** of the steps to be carried out in **the methods is essential or critical** to the claimed invention, the claims are failed as being incomplete for omitting essential elements, such omission amounting to a gap between the elements regarding claim 20. Therefore, the applicant failed to include the **necessary intermediate steps** like step 201, 205, 207, 211-217 of Figure 2.

6. For the above given reasons, the applicant's argument is not persuasive to place independent claims 20 and 22 in condition for allowance over prior arts in record. Dependent claims 21 and 22, depending directly from their claims 20 and 22 respectively in not placed in condition for allowance based on their dependency.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger et al. (hereinafter referred to as Geiger; WO 200072149 A1; International Publication date

11/30/2000) in view of Proust et al. (hereinafter referred to as Proust; US Pat. No.: 6,216,014 B1).

As per claims 20 and 22:

Geiger discloses an apparatus and a method comprising

a device for enabling integrity checking of a software module to be used in a mobile communication terminal (figure 1:10; page 3: lines 13-20), said terminal capable of communicating in a mobile communication system (figure 1: 20, 21), said software module ready for use except, before allowing the software module to take control of the terminal, the terminal communicates via the mobile communication system with a software provider (page 4: lines 8-15; figure 3: 200-230),

said communication including:

a transmitter for transmitting by said terminal of identifying information concerning said terminal to said software provider (page 4: lines 1-5, lines 22-25),

a receiver for receiving by said terminal a digitally signed data block comprising a reference value for use during integrity checking of said software module, and allowing the software module to take control of the terminal only if the integrity of the software module properly checks (page 4L lines 1-5, lines 8-15, lines 22-25; figure 3: 200-230).

Geiger does not explicitly disclose software module stored on a removable memory unit connected to the terminal and identifying information of the memory unit. Proust, in analogous art, however discloses software module stored on a removable memory unit connected to the

terminal and identifying information of the memory unit (column 10: lines 36-55). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Geiger to include software module stored on a removable memory unit connected to the terminal and identifying information of the memory unit. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a cellular communications system in which each user card can securely and independently manage a plurality of applications, which is to enable each application vendor to prevent applications other than its own from accessing at least some of the objects (for example files) of the user card which support his application and in addition to update (or reconfigure) user card objects which support the various applications, while ensuring that these applications continue to be managed in a secure and independent fashion as suggested Proust in (Column 3: lines 35-51).

As per claims 21 and 23:

Geiger discloses an apparatus and method comprising:

a device for hashing the software module, resulting in a first hash value, wherein said transmitting of identifying information comprises transmitting a first identifier, associated with the memory unit, a second identifier, associated with the terminal and the first hash value via the mobile communication system to said software provider (page 6: lines 10-20; page 8: lines 6-13),

a device for receiving, from the software provider, a data block comprising a digital signature and further data associated with the memory unit and the terminal (page 7: lines 7-11),

a device for analyzing the received data block, comprising verification of the digital signature and comparison of said further data with said first and second identifiers (figure 1: 26, 14, 23, 22), and

a device for storing the received data block comprising the digital signature, thereby providing a reference value for use during integrity checking of said software module (figure 1: 30, 31).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See the notice of reference cited in form PTO-892 for additional prior art.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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### *Contact Information*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Techane J. Gergiso whose telephone number is (571) 272-3784 and fax number is ~~(571) 273-3784~~. The examiner can normally be reached on 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T.G/

Art Unit 2137

January 24, 2008

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